

**Remarks**

Claims 1-44, 49, 50, 53, 57 and 58 are pending in the application. Claims 1-35, 38-44, 49, 50, 53, 57 and 58 have been amended in a good faith effort to place the claims in condition for allowance. Entry of the Amendment is respectfully requested to advance the prosecution of this case to allowance or to narrow the issues between Applicants and the Examiner in the event of appeal. The amendments to Claims 1-35, 38-44, 49, 50, 53, 57 and 58 were made to eliminate the reference to "prodrugs"; therefore, no new matter has been added to the claims.

***35 USC §112 Rejections******I. Claims 1-35, 38-44, 49, 50, 53, 57 and 58 were rejected under 35 USC §112, 1<sup>st</sup> paragraph as being non-enabled.***

Although Applicants disagree with Examiner's assertion that Applicants failed to provide an enabling disclosure and stand by their arguments of record, Applicants for purposes of expediting this case to allowance have deleted all references to prodrugs. Consequently, the amendments to the claims have rendered the rejection moot.

***II. Claims 38, 39, 49 and 50 were rejected under 35 USC §112, 2<sup>nd</sup> paragraph as being indefinite.***

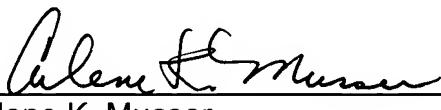
Applicants strongly disagree with Examiner's assertion that Claims 38, 39, 49 and 50 fail to meet the statutory requirements for §112, second paragraph. Uses of compounds that inhibit activities at the  $\beta_3$  adrenergic receptor are well known in the art. It is irrelevant that additional disorders may be discovered in the future that are also modulated by  $\beta_3$  adrenergic receptor inhibitors. The mere fact that the compounds of the present invention inhibit activity at the  $\beta_3$  adrenergic receptor is sufficient and supports the primary purpose of the patent system to encourage further discoveries. If someone discovers a new use, then that person(s) would be able to patent that invention in its own right. The new use does not distract from the inherent properties of the present compounds or

render them unpatentable for their function as inhibitors to treat known diseases associated with such inhibition. For the foregoing reasons and reasons already of record, Applicants respectfully submit that Claims 38, 39, 49 and 50 meet the statutory requirements for §112, second paragraph and that the rejection should be withdrawn. In addition, since Claim 53 is dependent from Claims 49 and 50, it would be allowable as well.

Applicants respectfully submit that Claims 1-44, 49, 50, 53, 57 and 58 are in condition for allowance and request a timely notice of allowance.

Respectfully Submitted:

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